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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,554

12/10/2003

Fred J. Molz IV

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7729

46333 7590 12/28/2006  
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EXAMINER

SWIGER III, JAMES L

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/28/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,554	<b>Applicant(s)</b> MOLZ ET AL.	
	<b>Examiner</b> James L. Swiger	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-12 and 37-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-12, and 37-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/10/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: On page 6 paragraph {00014} the specification describes a "fist joint." It is not understood what exactly a "fist joint" is, other than perhaps this is a typographical error.

Appropriate correction is required.

### ***Claim Objections***

Claims 42 and 51 are objected to because of the following informalities:

In claim 42, line 11, applicant claims a connector covering the "fist joint." It is unclear as to what exactly a "fist joint" is and is assumed to be a typographical error.

In claim 51, line 10, applicant claims a connector covering the "fist joint." It is unclear as to what exactly a "fist joint" is and is assumed to be a typographical error.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8-12 and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Atkinson et al. (US 6,402,750). Atkinson et al. disclose a surgical implant for the spine having a first and second biocompatible implant (see Fig. 4b) that is

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capable of attachment to the superior and inferior vertebrae, respectively, and that are biocompatible (See Col. 14, lines 35-55). The two attachment devices also provide a distracting force enabling proper spacing between the first and second pedicles. The implants may also provide a compressive force. (See Col. 9, lines 28-43.) The device of Atkinson et al. also teaches a prosthetic device that has a means for providing posterior devices (See Col. 23, lines 44-46), and a means for adapting one or more of the devices to the first and second transverse processes for spinous processes for attachment to laminae (as an adjustable arm 114), a means for removing at least a portion of the facet joint (see Col. 13, lines 34-44, inherently describing the use of the drill that removes a portion of the joint for securing the prosthetic device). Atkinson et al. also discloses elasticity based on the material chosen (Col. 10, lines 12-19).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 and 40-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. '750 in view of Zucherman et al. (US 6,652,527) and Simonson (US Publication 2005/0101956). Atkinson et al. disclose the claimed invention except for a surgical implant with a joint component with both components having elongated

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members enabling the first and second biocompatible members to rotate relative to one another with the flexible member and wherein the joint component comprises a covering and an elastic material. Zucherman et al. disclose a elongated joint members (108 and 114) that permit the spinous processes to move relative to one another (see Col. 4, lines 8-29) and also have holes at one end for the location of the joint (where 102 meets at the center of the two elongated members). Also, the portion 102 and the accompanying nut are considered a connector for the purpose of the joint.

Atkinson et al. further does not disclose specifically the use of elastic material in the device, either in the joint or connector. Simonson teaches the use of elastic material the increase resistance and connectivity of the device (see paragraph 0020).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Atkinson et al. having at least a joint and elongated members between the attachment devices in view of Zucherman et al. and the elastic material of Simonson to allow the two portions to better orient with each other in use.

### ***Response to Arguments***

Applicant's arguments filed 10/10/2006 have been fully considered but they are not persuasive.

It is held that Atkinson et al. discloses the claimed invention as rejected *supra*. The action has been clarified to more clearly distinguish the first and second devices and the flexible member. Atkinson et al. further discloses that the procedure is intended to be minimally invasive and also the device is capable of providing support to the facet

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joints. Also as in Atkinson creates a tension between the desired attachment devices, Zucherman et al. is provided to create a specific joint as the claims require.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



12/19/06

JLS



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER